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AFFYMETRIX, INC
ATTN: CHIEF IP COUNSEL, LEGAL DEPT.
3380 CENTRAL EXPRESSWAY
SANTA CLARA CA 95051

COPY MAILED

AUG 25 2004

In re Application of : OFFICE OF PETITIONS
Calvin F. Quate et al. :
Application No. 10/072,414 : DECISION GRANTING PETITION
Filed: February 5, 2002 :
Attorney Docket No. 3053.1C :
:

This is a decision on the petition filed November 26, 2002 under 37 CFR § 1.181, § 1.182 or § 1.183 to allow the submission of electronic copies (on CD-ROM) of references cited in the IDS. The petition is treated under 37 CFR § 1.182.

For documents that are cited in an Information Disclosure Statement (IDS), 37 C.F.R. § 1.98(a)(2) requires a legible copy be submitted of each citation. Papers that are to be part of the permanent Office records in a patent application are to be on either A4 or 8.5 by 11 inch paper. See 37 C.F.R. § 1.52(a)(iii). While there is an exception for previously submitted copies of the reference in another application, the earlier submitted copy can not be used unless the other application is relied upon under 35 U.S.C. 120 for an earlier effective filing date. See 37 C.F.R. § 1.98(d)(1).

The Office now accepts portions of patent applications on CD-ROM and CD-R media, under 37 C.F.R. § 1.52(e) when the data is submitted as an ASCII file. Other media such as CD-RW are not permitted. No other file formats are permitted. The compact discs become part of the permanent record of the application.

It is also possible for applicant to comply with 37 CFR § 1.98 for U.S. Patents and U.S. Patent application publications by submitting references via "e-IDS"¹ without filing copies of U.S. Patents and U.S. Patent application publications. The Office provides electronic storage and review systems to examiners for U.S. Patents and U.S. Patent application publications. The petition does not state why "e-IDS" cannot be employed to meet the requirements of 37 CFR § 1.98 for any U.S. Patents and U.S. Patent application publications. Hence, if the page volume of all the copies is the problem, it is not clear from the petition why filing a compact disc is necessary rather than filing an e-IDS for U.S. Patents and U.S. patent application publications.

¹ The instructions for submitting an e-IDS can be downloaded at:
http://www.uspto.gov/ebc/efs/downloads/documents/EFSePAVE_April23.pdf

The Office is converting all pending applications to an electronic Image File Wrapper (IFW) system where only the citation of U.S. Patents and U.S. patent application publications are stored. No copy of U.S. Patents and U.S. patent application publications are stored in an IFW application because the Office provides separate storage and review systems for U.S. Patents and U.S. Patent application publications. Copies of foreign patents and non-patent literature references are scanned from paper copies into the IFW application. The scanning of references permits multiple Office employees to review the references in the application and the public to review the foreign patents when the application is published or issued as a patent.

While the Office is working on acceptance of non-ASCII files to be part of the permanent record of a patent application that work is not yet complete. There is no program in place at the present time for acceptance of non-ASCII files. The only clear method of archiving the material submitted on the compact disc or loading it into the IFW is to print them to paper. Thus the Office would not be relieved of the burden of storing paper and would incur the additional burden of processing the compact discs and producing a paper copy from the discs.

With respect to the burden of voluminous paper copies imposed upon applicant and the Office, as explained above, the acceptance of compact discs would not relieve the Office of having to produce a paper copy of the contents of the compact disc and store the compact disc. Accepting the compact discs would create additional adverse impacts on the Office.

Adverse impacts on the PTO if the petition is granted:

A. Training issues:

Examiners have not been trained to review anything on compact disc, except for compact discs in compliance with 37 CFR § 1.52(e). The compact disc filed does not contain files in compliance with 37 CFR § 1.52(e). Accordingly, the Office cannot be certain that examiners have the necessary training to review the material on compact disc.

B. Virus and computer system compatibility issues:

Examiner's workstations are networked together and to numerous other Office systems. Because of this connectivity, additional procedures are followed for using computer media such as compact discs from outside sources. It is Office policy to test computer media from outside sources for viruses. If the submitted media contains executable programs the Office will further test the submission for compatibility with existing systems. Thus, the IDS discs coming from an external source will need to be checked

for computer viruses even if they do not contain the text search tool. In addition, since the discs contain an executable program, the search software, the discs will have to be analyzed for other problems that may affect the Office computer systems such as incompatibilities with network software and other Office software operating on an examiner's workstation.²

C. Electronic management issues:

The compact discs if accepted would become an electronic record of the PTO and subject to various electronic records management requirements. These requirements include developing a record disposition schedule, and providing media and file formats that continue to be usable with future PTO computer systems and software. See 36 CFR. § 1234.30. Ultimately, if transferred to the National Archives, the media and data formats would have to comply with the National Archive requirements or be converted to a form accepted by the National Archives. See 36 CFR. § 1228.188. Acceptable archivable media include Compact Disc-Read Only Memory (CD-ROM), but not other similar media which is rewritable such as Compact Disc-Read Write (CD-RW). For non-archivable formats the Office would be compelled to convert the compact discs to some other archivable form. Ultimately, if the archivable form is paper, the Office has then incurred additional expense with little ultimate gain.

Accordingly, the petition under 37 CFR § 1.182 regarding acceptance of the compact discs is **DISMISSED**.

Applicant can request reconsideration of this decision if the foreign patent and non-patent literature files can be modified to an acceptable archivable form that is compatible with Office computer systems that will not require an undue training and testing burden for the Office. Since the conversion of the data files to an ASCII format would lose all text format and drawing details their value may be significantly diminished and their acceptance by the Office would be less desirable.

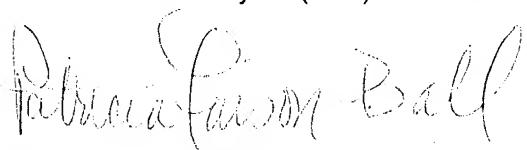
The petition is filed alternatively under 37 CFR § 1.181, § 1.182 and § 1.183. 37 CFR § 1.183 provides that "In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed." But even if that were the authority for the intended relief sought, the petition would fail as relief therein is reserved for extraordinary situations that don't traverse a statutory requirement. Furthermore, petitioner has not provided a basis for treatment of the petition under 37 CFR § 1.181. 37 CFR § 1.182 is reserved for

situations not specifically provided for in the regulations thus the petition is more appropriately treated under 37 CFR § 1.182.

In view of the above, a petition fee in the amount of \$130.00 will be charged to deposit account no. 01-0431.

The application is being forwarded to Technology Center 1637 for examination in due course.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (703) 305-4497.



Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions